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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,806	06/26/2001	Yong Jin Chang	858-11 CIP	2661
23869	7590	05/07/2004		
HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			EXAMINER COMSTOCK, DAVID C	
			ART UNIT 3732	PAPER NUMBER
			DATE MAILED: 05/07/2004	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/891,806

Applicant(s)

CHANG ET AL.

Examiner

David Comstock

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10 and 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Allowable Subject Matter

The indicated allowability of claims 16 and 19 is withdrawn in view of the double patenting rejection set forth below.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 5-7, 15, 16, 18, and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,354,304 ('304), as set forth below. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 1-6 of U.S. Patent No. 6,354,304 are of record. Claims 1, 3, 5 of the present application are substantially the same as claim 2 (which includes the limitations of claim 1) of ('304) except that the application refers to only "at least a portion of the

nail bed" being visible instead of the nail bed being "entirely substantially clear and transparent" as in ('304). Likewise, the application refers to a "continuous" opaque decoration that obscures only "at least a portion" of the tip instead of simply an "opaque decoration that obscures the tip" as in ('304). These changes are nothing more than changes in the general range of size of the transparent portion and the opaque portion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the range of sizes of the transparent portion and the opaque portion, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Claim 6 of the present invention is substantially the same as claim 3 of ('304). Claim 7 of the present invention is substantially the same as claim 4 of ('304). Claim 15, directed to a kit, is substantially the same as claim 5 of ('304) except that claim 15 includes the obvious change in the range of size of the transparent portion and the opaque portion, as explained above with reference to claim 1. In addition, claim 15 refers to white paint which claim 5 of ('304) does not. However, it would also have been obvious to use white paint to form the opaque tip since it is old and well known in the art to provide a French Manicure using white paint (see e.g. Carroll et al. 5,908,035, cited by applicant, col. 1, lines 49-60). Claim 16, also directed to a kit, is substantially the same as claim 5 with the only difference being the obvious difference in the range of size of the transparent portion and the opaque portion as discussed above. Claims 18 and 19 are substantially the same as claim 6 of ('304) except that both claims include the obvious difference in the

range of size of the transparent portion. Claim 18 also includes the obvious addition of white paint as discussed above with reference to claim 15.

Claim 2 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,354,304 as set forth above, and further in view of Agee, II et al. (D380,867). U.S. Patent 6,354,304 discloses the claimed invention except for the dividing line at an angle. Agee, II et al. disclose a similar device having a dividing line at an angle relative to the natural dividing line to provide a decorative appearance and enhance the ornamental appearance of the nails (see Fig. 1, Title, and Claim). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the artificial nail and tip of U.S. Patent 6,354,304 with a dividing line oriented at an angle relative to the natural dividing line, in view of Agee, II et al., in order to provide a decorative appearance and enhance the ornamental appearance of the nails.

Claims 8, 10, and 12-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-5 of U.S. Patent No. 6,354,304 in view of Chang (5,860,429). U.S. Patent No. 6,354,304 discloses the claimed invention except for the nail base portion corresponding in size and shape to the distal tip portion of a natural nail. Chang ('429) discloses that artificial nails having complete beds (Fig. 2a) and those corresponding to only the distal tip (Fig. 2) are functionally equivalent artificial nails known in the art (see Figs. 2a and 2 and col. 2, lines 52 and 53). Therefore, it would have been obvious to substitute artificial nails having a base corresponding in size and shape only to the distal portion of the natural

nail instead of to the entire bed since this is nothing more than the substitution of equivalent artificial nail structures known in the art. Claim 13 is substantially the same as claim 3. Claim 14 is substantially the same as claim 4.

Claim 9 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,354,304, as set forth above, and further in view of Agee, II et al. (D380,867). U.S. Patent 6,354,304 discloses the claimed invention except for the dividing line at an angle. Agee, II et al. disclose a similar device having a dividing line at an angle relative to the natural dividing line to provide a decorative appearance and enhance the ornamental appearance of the nails (see Fig. 1, Title, and Claim). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the artificial nail and tip of U.S. Patent 6,354,304 with a dividing line oriented at an angle relative to the natural dividing line, in view of Agee, II et al., in order to provide a decorative appearance and enhance the ornamental appearance of the nails.

Claims 17 and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5 and 6, respectively, of U.S. Patent No. 6,354,304, as set forth above, and further in view of Ferrigno (4,450,848; cited by applicant).

U.S. Patent No. 6,354,304 discloses the claimed invention, as set forth above, except for the transparent acrylic filler. Ferrigno discloses an artificial fingernail forming method comprising applying a transparent filler having an acrylic powder along with a liquid cyanoacrylate adhesive rearward of the tip, allowing the combination to harden,

and buffing it. This allows the artificial nail to remain on the natural fingernail longer and increases the potential market for the device, i.e., to men etc. (see col. 1, lines 15-29 and 42-53 and col. 2, Examples). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the artificial nail applying method or kit of U.S. Patent No. 6,354,304 with acrylic filler composed of powder and liquid cyanoacrylate, in view of Ferrigno, in order to allow the artificial nail to remain on the natural fingernail longer and increase the potential market for the device.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Comstock whose telephone number is (703) 308-8514.



D. Comstock
30 April 2004


KEVIN SHAVER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700